

REMARKS

Independent claims 1, 10 and 18 and claims that depend thereon are pending. Claims 1, 10, and 18 are amended to more particularly articulate the invention, and claim 20 is amended to correct a punctuation mistake.

Response to Objection

Claim 20 has been amended to end in a period to correct the identified punctuation error of the claim. The Examiner is thus requested to withdraw the objection to pending claim 20.

Rejections Under 35 USC §103

The Examiner rejects claims 1, 10, and 18 under 35 USC 103 as being obvious under *Ragsdale-Elliott, et al.* (“Ragsdale”) in view of *Miller, et al.* (“Miller”). For the following reasons, the rejections under 35 USC 103 do not raise a prima face case of obviousness, are improperly applied, and should be withdrawn.

1. There Must Be a Basis in the Art for Combining or Modifying References

A. IMPROPER COMBINATION OF REFERENCES—NO MOTIVATION TO COMBINE, REFERENCES TEACH AWAY FROM THEIR COMBINATION

MPEP§ 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of prima facie to determine whether it has been properly made. Thus, *In re Geiger, supra*, stated, in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some *teaching, suggestion or incentive* (ie, “motivation”) supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572,

Of course, application of §103 presumes the existence of differences between the subject matter claimed and the teachings of any particular prior art reference. Otherwise, a rejection under §102 would have sufficed. Thus, the Examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention. The Federal Circuit's assessment in *Geiger*, quoted above, is directed to the sufficiency of the teachings of a particular reference to justify a conclusion that any proposed modification or combination of references is what one of ordinary skill in the art would have found obvious to do at the time the invention was made.

However, in the present situation *Ragsdale* teaches a "maitre d' system and method which provides electronic interactive communication *with a waiter/waitress . . . a pager unit configured to fit in the palm of a waiter/waitress . . .*" See *Ragsdale's* Abstract. By contrast, *Miller* teaches a video-conference system to provide restaurant patrons the ability to communicate booth-to-booth primarily *between each other*. See *Miller's* Abstract. *Miller* does not even address the problem of customer ordering, service, or check-out; in fact, *Miller* states that his system generates revenue "*beyond* the conventional restaurant revenue sources of food, retail merchandise, and liquor . . ." (Column 1, lines 30-36). *Ragsdale* is specifically directed toward generating revenue *from* "food, retail merchandise, and liquor" (Generally, paragraph 16). Thus, not only are the reference not properly combinable, they actually teach away from their combination.

B. IMPROPER COMBINATION OF REFERENCES—NO SPECIFIC MOTIVATION CITED IN THE REFERENCES TO SUPPORT THEIR COMBINATION

The CCPA has expressly held that there must be some logical reason apparent from the evidence of record that would justify a combination or modification of references. *In re Regel*, 188USPQ 132 (CCPA 1975). In determining whether one of ordinary skill in the art would find it obvious to modify or combine references, the teachings of the reference taken with the knowledge that a worker in the art already possesses constitute the scope and content of the prior art that is

referred to in the *Graham* decision. Thus, the question raised under § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. Accordingly, *even if* all elements of a claim are disclosed in various prior art references (and, here they are not all disclosed), the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. *In re Regel, supra*.

The Examiner does provide one purported motivation for combining the references “It would have been obvious to one of ordinary skill in the art [note—not defined in the Office Action] at the time of the invention to have included the features of Ragsdale within the system of Miller with *the motivation* of providing a wireless maitre d’ system and method which allows interactive two-way communication to selective restaurant personnel for expeditiously receiving, filling, and finalizing patron orders in and outside of restaurants. [emphasis added]” Not only is this incorrect, it is a mischaracterization of the Applicant’s claims.

Further, this is not a “motivation” under the statute, merely a statement of an objective [“goal”] of Ragsdale, and is stated without citing any teaching of Ragsdale that would actually achieve that result. Thus, it is still entirely unclear how one would be motivated to pick up *Miller* whilst holding *Ragsdale* to solve a solution identified by either. Additionally, such citation wholly ignores the fact that within itself *Ragsdale* always contemplates communication with a maitre d’; whereas the teachings of the present invention, and the elements of the Applicant’s claims always call out and contemplate the elimination of communications with a maitre d’ or other wait staff.

Rather, the language of the Office Action cited above illustrate an impermissible basis for a “motivation” to combine references: hindsight reasoning. *To wit:*

C. APPARENT BASIS OF COMBINATION—HINDSIGHT REASONING

The Federal Circuit has repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d. 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) address this subject, *viz*:

a) Hindsight Syndrome

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect taught is used against the teacher." (*Id.* At 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*Id.* at 1369, 55 USPQ2d at 1316) (citations omitted).

(c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ...

Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not “evidence.” (*Id.* at 1370, 55 USPQ2d 1317) (citations omitted).

Clearly, the statement “It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of *Ragsdale* within the system of *Miller* with *the motivation* of providing a wireless maitre d’ system and method which allows interactive two-way communication to selective restaurant personnel for expeditiously receiving, filling, and finalizing patron orders in and outside of restaurants” says enough. No more than the Applicant’s own claims are forming the outline of the Examiner’s rejection, and the purported “motivation” is merely a statement of conclusionary reasoning designed to get the Examiner to where he can not otherwise go.

Additionally, to address the requirements of finding a motivation more specifically, the Examiner does not provide a single motivation for either combining *Ragsdale* with *Miller* to achieve the invention as defined in claims 1, 10, or 18. Nor does the Examiner identify what changes are being made to *Ragsdale* with *Miller* (and, clearly, changes must be made to get the two incompatible systems (CDPD “push” technology vs. compressed internet-enabled video), to communicate) to achieve the invention as defined in the Applicant’s claims. The reason why is clear—it cannot be done (absent an SMS Gateway and subscription, which none of the art nor present invention discuss; which, if done, still would not teach the Applicant’s invention as claimed).

The Applicant is thus left to guess the nature of the alterations and to guess the motivations for alterations. Accordingly, withdrawal of the rejections to claims 1, 10, and 18 based on *Ragsdale* in combination with *Miller* under 35 USC 103 is respectfully requested.

2. References Are Not Properly Combinable or Modifiable if Their Intended Function Is Destroyed

It goes without saying that if a prior art reference is cited that requires some modification in order to meet the claimed invention, or requires some modification in order to be properly combined with another reference, and such a modification destroys the purpose or function of the invention disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. Thus, the CCPA and the Federal Circuit have consistently held that when a §103 rejection is based upon such a modification of a reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made.

For the sake of argument, even if a modification of *Ragsdale* to send video was unthinkable at the time of the invention, and, as previously noted, modifying Miller to send CDPD messages (pager messages) would not be possible without additional and unsuggested modifications. Accordingly, the use of *Ragsdale* or *Miller* alone or in combination is further shown to be erroneous, and withdrawal of the rejections to the Applicant's invention under 35 USC 103 is respectfully requested.

3. References Are Not Properly Combinable or Modifiable if the Reference(s) Teach Away From the Modification or Combination

If the prior art teaches away from a combination, then a §103 rejection does not rise to the dignity of *prima facie* obviousness. It is unnecessary to submit rebuttal evidence when the reference used to reject the claim teaches away from the limitation, or is silent on it and other art teaches away. In short, teaching away is the antithesis of the art suggesting that the person of ordinary skill go into the claimed direction. *In re Fine*, 873 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). Essentially, teaching away from the art is a per se demonstration of lack of *prima facie* obviousness.

As noted above, in the present situation *Ragsdale* teaches a "maitre d' system and method which provides electronic interactive communication *with a waiter/waitress . . . a pager unit*

configured to fit in the palm of a waiter/waitress . . .” See *Ragsdale’s* Abstract. By contrast, *Miller* teaches a video-conference system to provide restaurant patrons the ability to communicate booth-to-booth primarily *between each other*. See *Miller’s* Abstract. *Miller* does not even address the problem of customer ordering, service, or check-out; in fact, *Miller* states that his system generates revenue “*beyond* the conventional restaurant revenue sources of food, retail merchandise, and liquor . . .” (Column 1, lines 30-36). *Ragsdale* is specifically directed toward generating revenue *from* “food, retail merchandise, and liquor” (Generally, paragraph 16). Thus, not only are the reference not properly combinable, they actually teach away from their combination.

4. Improper Characterization/Misapplication of Ragsdale and Miller Cited Teachings Against Elements of Applicant’s Claims

A. CLAIM 1

The Examiner cites *Miller* Column 8 line 53 through Column 9, line 8 for teaching “a software program that receives[, without the participation of wait-staff], at least one customer unit request of at least one service from a restaurant.” However, *Miller* states no such thing, and at least through the cited portion of *Miller*, is devoid of any teaching whatsoever. Rather, what the Examiner cites as a teaching can, at best, be characterized as a summary of *Miller’s* aspirations for future applications of his technology (having a waiter teach software use at a restaurant????). *Miller* does not teach the elements as purported by the Examiner; rather, Applicant’s invention teaches beyond *Miller’s* merely desired future as surely as the Harrier Jet is comprised of teachings beyond the Jetson’s saucer. Further, as *Miller* states in the cited Column 8 line 59 “ . . . by the presence of waiters in the restaurant . . .” whereas Applicant’s invention eliminates such a requirement. Because it is shown that *Miller’s* teachings regarding more than one element (actually all elements) for which it is cited. It is unnecessary to examine the teachings of *Ragsdale*. Accordingly, withdrawal of the rejection to Claim 1 under 35 USC 103 is requested and it is requested that Claim 1 be allowed.

B. CLAIM 10

The Examiner cites Miller (Col 5, lines 60 – Col. 6, line 6; Col. 8, line 53 to Col. 9, line 8)¹, and Ragsdale (Paragraphs 0046, 0053, 0054) for that proposition that these references teach or suggest a software program that receives [, without the participation of wait-staff], at least one customer unit request of at least one service from a restaurant, the restaurant having a customer managed post-dining system that processes at least one customer data element via a self-check out and payment processing system, and a terminal device, located remotely from the software program, the terminal device adapted to allow a customer to operate the post-dining system, whereby, the method comprising a bill review act; a gratuity assignment act; a digital signature act; a payment processing act; a digital receipt storage act; and a customer receipt act. However, neither Miller nor Ragsdale stand for the propositions cited by the Examiner. For example, Miller merely states from column 5 line 60 through column six line 6 that “guest information flows automatically in a customer database for easy future booking, marketing, programs, and potential mailing list sales. Credit card information from initial reservation flows into restaurant POS (Point of Sale) system for easy bill payment. . . . [the remaining relating to intra-customer-booth-video communication].” That the Examiner maintains that this stands for the teaching of a “software program that receives a customer unit request of at least one service from a restaurant, the restaurant having a customer managed post-dining system” is remarkable. Clearly Miller does not teach the system claimed by the applicant nor any system combinable with that of Ragsdale. Should the Examiner maintain that such teachings exists, he is requested to more specifically state the grounds for his position.

As stated above, the combination of Miller with Ragsdale is merely a study in hindsight reasoning. Nevertheless, Ragsdale cannot be said to stand for teaching or suggesting those things claimed in the claims of the present invention. For example, the Applicant claims a system that utilizes a customer managed post-dining system that processes at least one customer data element via a self-check out and payment processing system, and a terminal device, located remotely from the software program, the terminal device adapted to allow a customer to operate the post-dining

¹ The Examiner specifically notes that Miller does not teach, show or suggest the other elements of claim 10.

system, whereby, the method comprising a bill review act; a gratuity assignment act; a digital signature act; a payment processing act; a digital receipt storage act; and a customer receipt act. First, Ragsdale requires a maitre d'. Second, Ragsdale does not track nor aggregate a bill, or assign a gratuity. Accordingly, even if Miller and Ragsdale are combined, they still do not teach the invention as claimed by the Applicant.

C. CLAIM 18

The Examiner cites Miller (Col. 6, lines 20-28; Col. 8, lines 7-24; Col. 8, lines 28-52), and Ragsdale (Paragraphs 16 and 53) for the proposition that they in combination teach identifying a number of people at a table; identifying a person associated with a menu item, splitting at least one restaurant item between at least two people; monitoring a bill balance; and; closing an individual bill balance [for one of the at least two people, without the participation of wait-staff].²

The Examiner suggests that Ragsdale teaches that a payment of a bill to form a method of monitoring a bill balance ("since customers or patrons have several options of payments"). However, Ragsdale does not teach anything even remotely similar to this characterization. Clearly, Ragsdale does not teach, show or suggest splitting at least one restaurant item between at least two people as claimed by the Applicant. Accordingly, even if Miller and Ragsdale are combined, they still do not teach the invention as claimed by the Applicant.

Thus, the rejections to independent claims 1, 10 and 18 should be withdrawn, and the allowance of these claims, and those that depend therefrom, are respectfully requested.

In the Event Arguments are Believed Insufficient

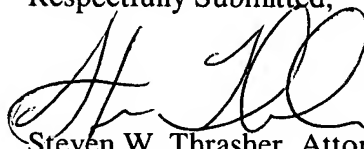
Should the Examiner disagree that the remarks place the application in condition for allowance, then the Examiner is respectfully requested to prepare an acceptable proposed set of claims pursuant to MPEP 707.07 (j).

² The Examiner expressly notes that Miller does not disclose a method that includes monitoring a bill balance, and closing an individual bill.

Thus, it is believed that the pending claims are allowable, and allowance of said claims is respectfully requested. Other references made of record but not relied upon in the Office Action are considered no more relevant to the invention than the reference relied upon by the Examiner.

If the Examiner has other matters which remain, the Examiner is encouraged to contact the under signed attorney to resolve these matters by Examiners Amendment where possible.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'S. W. Thrasher', written over a horizontal line.

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